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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/606,934	06/30/2000	Hiroshi Tanaka	0905-0239P-SP	8457
2292	7590	11/17/2003		
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER TRAN, PABLO N	
			ART UNIT	PAPER NUMBER
			2685	

DATE MAILED: 11/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/606,934

Applicant(s)

TANAKA, HIROSHI

Examiner

Pablo N Tran

Art Unit

2685

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 and 8-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. The Election/Restriction's Action (no. 4) issued by the examiner on 07/29/03 is withdrawn.
2. Newly submitted claims 15-30 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Regarding claim 15, a method of controlling the operations of an image communication system comprising the steps of transmitting the prepared image list, displaying an image list, and accepting an image identification selected in the display list, transmitting the accept image identification, transmitting the image data, and transmitting the received image data to a transmission destination through a communication network.

Regarding claim 17, a method of controlling the operations in a server and an image communication system comprising the steps of transmitting the kept image list or thumb-nail image list from said server to said portable telephone, displaying an image list or the thumb-nail image list, and accepting an image identification selected in the display image list or thumb-nail list, transmitting the accept image identification, transmitting the image data, and transmitting the received image data to the image processor.

Art.Unit: 2685

Regarding claim 19, a portable telephone set capable of establishing data communication with an image processor comprising list command means, list receiving means, selection means, image request means, and image transmitting means.

Regarding claim 22, a portable telephone set capable of establishing data communication with a server comprising list command means, list receiving means, selection means, image request means, and image transmitting means.

Regarding claim 25, a digital camera capable of establishing data communication with a MS comprising list creation means, list transmitting means, and image transmitting means.

Regarding claim 29, a digital camera capable of establishing data communication with a portable telephone comprising list creation means, receiving means, and image transmitting means.

Regarding claim 30, a portable telephone set capable of establishing data communication with an image processor comprising command means, first receiving means, a display device, selection means, image request means, second receiving means, and image transmitting means.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 15-30 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Alperovich et al.* (6,317,609) in view of *Niwa* (6,538,692).

As per claims 1, 3-4, 6, and 8-14, *Alperovich et al.* disclose an image communication system in which an image processor (see fig. 3/no. 300) and a portable telephone set (fig. 3/no. 20) can establish data communication with an image processor comprising a reading command to read out the image data being issued to the image processor from the portable telephone, wherein said image processor transmitting the stored image data to said portable telephone set in response to the reading command issued from said portable telephone, and wherein said portable telephone set comprises setting means for setting a destination of transmission of the image data, receiving the image data transmitted from said image processor, and a second transmission means for transmitting the received image data to the destination of transmission set by said setting means through a communication network (col. 4/ln. 21-59).

Alperovich et al. do not disclosed such judging means to judge whether or not the storage has enough space to store the image data. However, such is well known in the art, as taught by *Niwa* (col. 5/ln. 63-col. 6/ln. 6-14). Therefore, it would have been obvious to one of ordinary skill in the art to provide such judging method, as taught by

Art.Unit: 2685

Niwa, to the communication system of *Alperovich et al.* in order to allow all desired image data to be recorded without interruption.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Monroe et al. (6,181,954), Aarnio (6,522,889), Tanaka et al. (6,392,697), Safai et al. (6,167,469), Suso et al. (6,069,648), Suso et al. (6,466,202), McDonnell et al. (6,567,661), Tullis (6,535,243), Lourette et al. (5,978,016), Schelling et al. (5,706,097), Hull et al. (5,806,005), Aoki et al. (EP0930770A2), Evans (EP1189424A1), and Anderson et al. (WO9948276) disclose radiotelephone communication system.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pablo Tran whose telephone number is (703)308-7941. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban, can be reached at (703)305-4385.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Art.Unit: 2685

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

PABLO N. TRAN
PRIMARY EXAMINER

November 13, 2003

A handwritten signature in black ink, appearing to be 'P. Tran', enclosed within a large, loopy oval.

#V2685